

ESTTA Tracking number: **ESTTA767998**

Filing date: **08/31/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	McDonald's Corporation
Granted to Date of previous extension	08/31/2016
Address	One McDonald's Plaza Oak Brook, IL 60523 UNITED STATES

Attorney information	John A. Cullis Reed Smith LLP 10 South Wacker Drive, 40th Floor Chicago, IL 60606 UNITED STATES ipdocket-chi@reedsmith.com, rsMcDonaldsTMTeam@ReedSmith.com, mben-son@reedsmith.com Phone:312-207-1000
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Applicant Information

Application No	86836509	Publication date	05/03/2016
Opposition Filing Date	08/31/2016	Opposition Period Ends	08/31/2016
Applicant	Sullivan Restaurant's Inc 706 Washington Street Walpole, MA 02081 UNITED STATES		

Goods/Services Affected by Opposition


Class 043. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Fast-food restaurant services; Restaurant and catering services; Restaurant services; Restaurant services, including sit-down service of food and take-out restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises; Take-out restaurant services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1126102	Application Date	04/30/1973
Registration Date	10/16/1979	Foreign Priority	NONE

		Date	
Word Mark	BIG MAC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1957/00/00 First Use In Commerce: 1957/00/00 SANDWICH		

U.S. Registration No.	1331342	Application Date	09/29/1982
Registration Date	04/16/1985	Foreign Priority Date	NONE
Word Mark	BIG MAC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1967/00/00 First Use In Commerce: 1967/00/00 Restaurant Services		

U.S. Registration No.	2035287	Application Date	12/13/1995
Registration Date	02/04/1997	Foreign Priority Date	NONE
Word Mark	BIG MAC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1967/00/00 First Use In Commerce: 1967/00/00 sandwich for consumption on or off the premises		


U.S. Registration No.	3752293	Application Date	08/07/2009
Registration Date	02/23/2010	Foreign Priority Date	NONE
Word Mark	BIG MAC ATTACK		

Design Mark	BIG MAC ATTACK
Description of Mark	NONE
Goods/Services	Class 043. First use: First Use: 1976/11/14 First Use In Commerce: 1976/11/14 RESTAURANT SERVICES

U.S. Registration No.	3775834	Application Date	12/18/2008
Registration Date	04/13/2010	Foreign Priority Date	NONE
Word Mark	MAC SNACK WRAP		
Design Mark	MAC SNACK WRAP		
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2009/06/01 First Use In Commerce: 2009/06/01 SANDWICHES MADE OF MEAT, POULTRY, CHEESE, VEGETABLES AND SAUCE		

U.S. Registration No.	4336178	Application Date	04/27/2012
Registration Date	05/14/2013	Foreign Priority Date	NONE
Word Mark	MAC TONIGHT		


Design Mark	MAC TONIGHT
Description of Mark	NONE
Goods/Services	Class 043. First use: First Use: 2008/09/30 First Use In Commerce: 2008/09/30 RESTAURANT SERVICES


U.S. Registration No.	1352168	Application Date	05/23/1983
Registration Date	07/30/1985	Foreign Priority Date	NONE
Word Mark	MC DONALD'S		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1968/12/31 First Use In Commerce: 1968/12/31 RESTAURANT SERVICES		

U.S. Registration No.	1426681	Application Date	09/30/1982
Registration Date	01/27/1987	Foreign Priority Date	NONE
Word Mark	MCDONALDS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 029. First use: First Use: 1948/00/00 First Use In Commerce: 1953/05/00 CHICKEN, HASHBROWN POTATOES, PREPARED EGGS, MILK, FRESH GARDEN SALADS AND PROCESSED INGREDIENTS THEREOF, FOR CONSUMPTION ON OR OFF THE PREMISES</p> <p>Class 030. First use: First Use: 1948/00/00 First Use In Commerce: 1953/05/00 HAMBURGER AND CHEESEBURGER SANDWICHES AND SPECIAL COMBINATION SANDWICHES FEATURING HAMBURGERS AND CHEESEBURGERS, [ROAST BEEF SANDWICHES, HOT CHOCOLATE, PREPARED CATSUP, COOKIES,] HOTCAKES, TABLE SYRUP, FRUIT PIES, SPECIAL COMBINATION EGGSANDWICHES, TEA, [COFFEE, SOFT SERVE ICE CREAM OR ICE CREAM SUBSTITUTE, ICE CREAM OR ICE CREAM SUBSTITUTE SUNDAES, SOFT SERVE ICE MILK, SOFT SERVE ICE MILK SUNDAES, DONUTS,] PASTRIES, CHICKEN SANDWICHES, PORK SANDWICHES, [</p>		

	BISCUIT AND HAM SANDWICHES] AND BISCUIT AND SAUSAGE SAND- WICHES FOR CONSUMPTION ON OR OFF THE PREMISES Class 032. First use: First Use: 1948/00/00 First Use In Commerce: 1953/00/00 CARBONATED AND NON-CARBONATED SOFT DRINKS AND FRUIT JUICES FOR CONSUMPTION ON OR OFF THE PREMISES		
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U.S. Registration No.	2482828	Application Date	06/19/1998
Registration Date	08/28/2001	Foreign Priority Date	NONE
Word Mark	MCCAFE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2001/05/02 First Use In Commerce: 2001/05/02 restaurant services		

U.S. Registration No.	3201441	Application Date	03/02/2006
Registration Date	01/23/2007	Foreign Priority Date	NONE
Word Mark	MCCAFE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2001/05/02 First Use In Commerce: 2001/05/02 BEVERAGES MADE OF COFFEE BEANS, HOT CHOCOLATE, PASTRIES, MUFFINS, CAKES, COOKIES, BISCUITS AND SANDWICHES		

U.S. Registration No.	939100	Application Date	07/22/1971
Registration Date	07/25/1972	Foreign Priority Date	NONE
Word Mark	MCDONALDLAND		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 042. First use: First Use: 1971/01/01 First Use In Commerce: 1971/01/01 RESTAURANT SERVICES


U.S. Registration No.	1266500	Application Date	06/21/1982
Registration Date	02/07/1984	Foreign Priority Date	NONE
Word Mark	MC DOUBLE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1977/06/30 First Use In Commerce: 1977/09/30 a Sandwich for Consumption On or Off Premises		


U.S. Registration No.	1315979	Application Date	06/11/1982
Registration Date	01/22/1985	Foreign Priority Date	NONE
Word Mark	MCRIB		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1981/06/30 First Use In Commerce: 1981/06/30 a Sandwich for Consumption On or Off the Premises		

U.S. Registration No.	1485633	Application Date	02/13/1984
Registration Date	04/19/1988	Foreign Priority Date	NONE
Word Mark	MCMUFFIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1983/05/00 First Use In Commerce: 1983/05/00 RESTAURANT SERVICES		

U.S. Registration No.	1450104	Application Date	09/30/1982
Registration Date	07/28/1987	Foreign Priority Date	NONE
Word Mark	MCNUGGETS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1980/04/00 First Use In Commerce: 1980/04/00 RESTAURANT SERVICES		

U.S. Registration No.	3151707	Application Date	05/12/2004
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Registration Date	10/03/2006	Foreign Priority Date	NONE
Word Mark	MCGRIDDLES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2000/10/31 First Use In Commerce: 2000/10/31 HOT CAKES		

U.S. Registration No.	4129420	Application Date	11/10/2010
Registration Date	04/17/2012	Foreign Priority Date	NONE
Word Mark	MCBITES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 2011/10/31 First Use In Commerce: 2011/10/31 MEAT, PORK, PROCESSED FISH AND POULTRY		

Attachments	72456124#TMSN.png(bytes) 77799534#TMSN.png(bytes) 77636011#TMSN.png(bytes) 85610197#TMSN.png(bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/John A. Cullis/
Name	John A. Cullis
Date	08/31/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of:
Application Serial No. 86/836,509

Published in the *Official Gazette*
on May 3, 2016

McDONALD'S CORPORATION,

Opposer,

v.

SULLIVAN RESTAURANT'S INC.,

Applicant.

Mark: MAC CITY

Opposition No.: _____

NOTICE OF OPPOSITION

Opposer, McDonald's Corporation, a corporation organized and existing under the laws of the State of Delaware, with offices at One McDonald's Plaza, Oak Brook, Illinois, 60523-1900, believes that it will be damaged by registration of the mark MAC CITY in International Class 43, as shown in Application Serial No. 86/836,509 filed by Applicant, Sullivan Restaurant's Inc., a corporation organized and existing under the laws of the State of Massachusetts, with a mailing address of 706 Washington Street, Walpole, Massachusetts 02081 and hereby opposes same and requests that registration to Applicant be refused.

The grounds for this Notice of Opposition are as follows:

1. Applicant seeks to register the mark MAC CITY for fast-food restaurant services; restaurant and catering services; restaurant services; restaurant services, including sit-down service of food and take-out restaurant services; restaurant services, namely, providing of food

and beverages for consumption on and off the premises; take-out restaurant services in International Class 43. The application is an intent to use-based application filed under 15 U.S.C. § 1051(b).

2. This Notice of Opposition is being timely submitted.

3. Since 1955, Opposer has been in the business of developing, operating, franchising, and servicing an extensive system of restaurants that prepare, package, and sell a wide variety of high quality, quickly-prepared, modestly-priced foods. Opposer has carried on this business in the United States and throughout the world. Opposer and its subsidiaries now operate or license thousands of restaurants throughout the world, including over 14,000 restaurants in the United States.

4. In connection with this business, Opposer has, for decades, extensively used its “Mc” and “Mac” family of marks, which includes “Mc” and “Mac” used with various generic or descriptive terms, as trademarks and service marks in advertising, promoting, and selling a wide variety of food products and restaurant services. For instance, Opposer has continuously and exclusively used its famous BIG MAC trademark in connection with restaurant services and sandwiches, namely, hamburgers, for over forty years. During that time, Opposer has also expanded the use of its “Mc” and “Mac” family of trademarks to include a wide variety of goods and services, including food products such as chicken, specialty sandwiches, breakfast items, pancakes, baked pastries, and restaurant services, all of which are advertised and promoted throughout the United States.

5. Opposer’s extensive advertising and promotion of its various goods and services under its family of “Mc” and “Mac” marks features the use of television and print advertising, radio, newspaper and magazine advertising, outdoor billboard and signage, Internet

advertising, mobile advertising and direct mail, which are directed to and reach the public in both local and nationwide markets. In addition, Opposer uses its “Mc” and “Mac” formative family of marks on food product packaging and point-of-purchase advertising. In sum, Opposer uses its “Mc” and “Mac” family of marks in connection with a wide variety of products and services, or is likely to expand the use of its family of “Mc” and “Mac” marks to products and/or services identical, similar or related to those for which Applicant’s MAC CITY mark is intended to be used by Applicant.

6. Opposer owns numerous federal registrations for its family of “Mc” and “Mac” marks. These registrations include, but are not limited to, the following:

	<u>MARK NAME</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
1.	BIG MAC	1,126,102	10/16/1979	Sandwich
2.	BIG MAC	1,331,342	04/16/1985	Restaurant services
3.	BIG MAC	2,035,287	02/04/1997	Sandwich for consumption on or off the premises
4.	BIG MAC ATTACK	3,752,293	02/23/2010	Restaurant Services
5.	MAC SNACK WRAP	3,775,834	04/13/2010	Sandwiches made of meat, poultry, cheese, vegetables and sauce
6.	MAC TONIGHT	4,336,178	05/14/2013	Restaurant services
7.	McDONALD’S	1,352,168	07/30/1985	Restaurant services

<u>MARK NAME</u>		<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
8.	McDONALD'S	1,426,681	01/27/1987	Chicken, hashbrown potatoes, prepared eggs, milk, fresh garden salads and processed ingredients thereof, for consumption on or off the premises; Hamburger and cheeseburger sandwiches and special combination sandwiches featuring hamburgers and cheeseburgers, hotcakes, table syrup, fruit pies, special combination egg sandwiches, tea, pastries, chicken sandwiches, pork sandwiches, and biscuit and sausage sandwiches for consumption on or off the premises; Carbonated and non-carbonated soft drinks and fruit juices for consumption on or off the premises
9.	McCAFE	2,482,828	8/28/2001	Restaurant services
10.	McCAFE	3,201,441	01/23/2007	Beverages made of coffee, pastries, muffins, cakes, cookies, biscuits, and sandwiches
11.	McDONALDLAND	0,939,100	07/25/1972	Restaurant services
12.	Mc DOUBLE	1,266,500	02/07/1984	A sandwich for consumption on or off premises
13.	McRIB	1,315,979	01/22/1985	A sandwich for consumption on or off premises
14.	McMUFFIN	1,485,633	04/19/1988	Restaurant services
15.	McNUGGETS	1,450,104	07/28/1987	Restaurant services

	<u>MARK NAME</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
16.	McGRIDDLES	3,151,707	10/03/2006	Hot cakes
17.	McBITES	4,129,420	04/17/2012	Meat, pork, processed fish and poultry

7. All of these registrations are valid, subsisting, and in full force and effect. Furthermore, Opposer has used these marks in association with their respective designated goods and services prior to December 2, 2015, the filing date of Applicant's MAC CITY trademark application.

8. Each of the aforesaid registrations is at least *prima facie* evidence of the validity of each registration, of Opposer's ownership thereof, and of Opposer's exclusive right to use such registered marks on the goods or services set forth in the registrations.

9. In addition to the federally registered trademarks listed above, Opposer has also, from time to time, used or is using other "MAC" trademarks, such as the following:

MAC	MACISIMIZE YOUR MAC
MAC JR.	BLAST BACK YOUR MAC
MINI MAC	MORNING MAC
DOUBLE MAC	MACMAN
SUPER MAC	MAC FAMILY
XTREME MAC	MAC TO GO
MONSTER MAC	MAC PAC
LITE MAC	HAVE YOU HAD YOUR MAC TODAY?
6 PAC MAC	

10. Through Opposer's extensive and continuous use of the name McDONALD'S

and its “Mc” and “Mac” marks, the public has come to recognize marks combining the “Mc” and “Mac” terms with a common word for a wide variety of goods and services as being uniquely associated with Opposer. Opposer has developed, at great effort and expense, exceedingly valuable goodwill with respect to the specific marks listed above, as well as for its entire “Mc” and “Mac” family of marks. Opposer’s “Mc” and “Mac” family of marks is famous and was famous long prior to the date of filing of Applicant’s subject application.

11. Both the Trademark Trial and Appeal Board and the Federal Circuit have long recognized the validity of Opposer’s rights to its famous “Mc” and “Mac” family of marks. *McDonald’s Corp. v. McClain*, 37 U.S.P.Q. 2d 1274, 1276 (TTAB 1995) (“The family of [McDonald’s] marks has been recognized by this Board and by the courts”); *McDonald’s Corp. v. McKinley*, 13 U.S.P.Q. 2d 1895, 1899 (TTAB 1989) (“In view of opposer’s extensive evidence of use and promotion of marks having a “Mc” or “Mac” portion, there can be no doubt that opposer has established that its marks comprise a family”); *McDonald’s Corp. v. McSweet, LLC*, 112 U.S.P.Q. 2d 1268, 2014 WL 5282256 at *7 (TTAB 2014) (“Based on the record before us, . . . Opposer has established that, based on its use and promotion of its family of marks, Opposer continues to own a family of marks consisting of the prefix ‘MC’ combined either with a generic term or a descriptive term.”); *McDonald’s Corp. v. McBagel’s, Inc.*, 649 F. Supp. 1268, 1272 (S.D.N.Y. 1986) (showing no hesitation in finding that McDonald’s “owns a ‘family of marks’ both registered and unregistered, whose common characteristic is the use of ‘Mc’ or ‘Mac’ as a formative”); *J&J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 1463 (Fed. Cir. 1991) (recognizing “McDonald’s specific family of marks wherein the prefix “Mc” is used with generic food names to create fanciful words.”)

12. Despite Opposer’s long-standing prior rights in the name McDONALD’S and

its “Mc” and “Mac” family of marks for restaurant services, food products, and a wide variety of other goods and services, on December 2, 2015, Applicant filed its application to register the MAC CITY mark for fast-food restaurant services; restaurant and catering services; restaurant services; restaurant services, including sit-down service of food and take-out restaurant services; restaurant services, namely, providing of food and beverages for consumption on and off the premises; take-out restaurant services in International Class 43. Moreover, in light of Opposer’s widespread advertising and promotion of its “Mc” and “Mac” marks, Applicant’s selection and use of the MAC CITY mark, which incorporates the “Mac” prefix, suggests that Applicant intends to trade off the goodwill and recognition associated with Opposer’s family of “Mac” marks.

13. The mark proposed for registration by Applicant has as its principal distinctive element the “Mac” prefix. Potential purchasers, upon seeing the dominant formative “Mac” in Applicant’s MAC CITY mark are likely to mistakenly believe that the services offered thereunder originated or are connected with, or are sponsored, licensed or approved by, Opposer. Thus, the registration and use by Applicant of the MAC CITY mark in connection with its services, for all channels of trade and all types of prospective purchasers, is likely to cause confusion, mistake, or deception in violation of 15 U.S.C. § 1052(d).

14. Issuance of a registration to Applicant will also diminish and dilute the distinctive quality of Opposer’s rights in the name McDONALD’S and its famous family of “Mac” marks, and will blur and otherwise impair the distinctiveness of this family of marks in violation of 15 U.S.C. § 1125(c).

15. If a registration is issued to Applicant for Applicant’s MAC CITY mark, the confusion with Opposer’s marks would result in damage and injury to Opposer and the public.

Registration of the MAC CITY mark would also give Applicant an unqualified right to wrongfully appropriate Opposer's valuable goodwill and reputation associated with Opposer's marks; to benefit from the likely confusion among purchasers led to believe that Applicant's services are related in some fashion to Opposer; to dilute the distinctiveness of Opposer's marks and harm its goodwill and reputation associated with its marks; to tarnish Opposer's good name by offering goods not subject to Opposer's quality controls; and to restrict the natural growth of Opposer's "Mac" family of marks.

WHEREFORE, Opposer requests that this Opposition be sustained and Application Serial No. 86/836,509 be refused registration.

The requisite filing fee of \$300.00 and any additional fees related to this matter are being charged to a MasterCard credit card concurrently with this filing.

Respectfully submitted,

McDONALD'S CORPORATION

Date: August 31, 2016

By: /John A. Cullis/ _____
Robert E. Browne
John A. Cullis
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10 South Wacker Drive, 40th Floor
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CERTIFICATE OF TRANSMISSION

I hereby certify that the foregoing **NOTICE OF OPPOSITION** is being electronically transmitted via the Electronic System for Trademark Trials and Appeals (“ESTTA”) at <http://estta.uspto.gov/> on the date noted below:

Date: August 31, 2016

By: /John A. Cullis/
One of the Attorneys for Opposer,
McDonald’s Corporation

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **NOTICE OF OPPOSITION** upon Applicant’s counsel of record for Application Serial No. 86/836,509 as listed with the USPTO:

Matthew H. Swyers
The Trademark Company PLLC
344 Maple Ave. W., Suite 151
Vienna, Virginia 22180

via First Class Mail, postage prepaid, in accordance with Trademark Rule § 2.119 on the date noted below:

Date: August 31, 2016

By: /John A. Cullis/
One of the Attorneys for Opposer,
McDonald’s Corporation